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| 10/701,444 | 11/06/2003 | Shinji Usuba | 32014-192412 | 7621 |

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| EXAMINER | |
|---|---|
| HYUN, SOON D | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/701,444 | USUBA ET AL. | |
| | Examiner | Art Unit | |
| | SOON-DONG D. HYUN | 2616 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6 and 10-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 10-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Objections*

2. Claims 10 and 15 are objected to because of the following informalities: Appropriate correction is required.

Each of claims 10 and 15 recites a limitation "adapted to" which is not a positive recitation. Under MPEP 2111.04, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim limitation."

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3, 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 3, the subject matter "analog telephone networks subscribers" which was not described in the specification at the time the application was filed, thus, is new matter.

Regarding claim 23, the subject matter "database" which was not described in the specification at the time the application was filed, thus, is new matter.

Regarding claim 24, the subject matter "time slots" which was not described in the specification at the time the application was filed, thus, is new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is meant by "time slots ... are converted... into the internet protocol packets", i.e., it is not clear how the time slots are converted to packets.

***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 6 and 10-14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 6-10 of prior U.S. Patent No. 7,382,766. This is a double patenting rejection.

Claim 6 of the instant application is substantially same as claim 1 of the patent.

Claim 10 of the instant application is substantially same as claim 6 of the patent.

Claim 11 of the instant application is substantially same as claim 7 of the patent.

Claim 12 of the instant application is substantially same as claim 8 of the patent.

Claim 13 of the instant application is substantially same as claim 9 of the patent.

Claim 14 of the instant application is substantially same as claim 10 of the patent.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 15-18 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 7 of U.S. Patent No. 7,382,766. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, 5, and 7 of U.S. Patent No. 7,382,766, respectively contains every element of claims 1, 3, 22, and 34 of the instant application, respectively.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (Decided: May 30, 2001).

Regarding claim 1, claim 2 of the patent contains every element of claim 15 of the instant application.

Regarding claim 15, claim 6 of the patent contains every element of claim 15 of the instant application.

Regarding claim 16, claim 7 of the patent contains every element of claim 16 of the instant application.

Regarding claim 17, claim 7 of the patent contains every element of claim 17 of the instant application.

Regarding claim 18, claim 6 of the patent contains every element of claim 18 of the instant application.

Regarding claim 19, claim 7 of the patent contains every element of claim 19 of the instant application.

Regarding claim 20, claim 7 of the patent contains every element of claim 20 of the instant application.

Regarding claim 21, claim 7 of the patent contains every element of claim 21 of the instant application.

Regarding claim 22, claim 6 of the patent contains every element of claim 21 of the instant application.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-5 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fechalos (U.S. Patent No. 4,737,950) in view of Civanlar (U.S. Patent No. 5,737,333).

Regarding claims 1 and 18, Fechalos teaches in fig. la, a host switching system (a LAN switching Unit) connecting plurality of interfaces 10 which includes telephone concentrators and LAN concentrators (plurality of LAN hubs) wherein the concentrator is coupled to plurality of PCs (computing equipments).

However, Fechalos fails to explicitly teach converting the digital voice data into MAC frames to be relayed to the LAN interface.

Civanlar et al (Civanlar) teaches in Fig. 4, a RouTel (103) that includes plurality LAN adapters to receive telephone calls to be converted into MAC frames by LAN adaptor to be relayed over the LAN interface (col. 10, lines 18-40). One skilled in the art would have been motivated by Civanlar to modify the switching system 12 to include an MAC frame converter to receive telephone calls.

Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching of Civanlar into teaching of Fechalos.

Regarding claim 2, Civanlar further teaches that the Routel comprises a CPU (402) and LAN adapter 164-1 (a second LAN interface).

Regarding claims 3, 4, and 15, Civanlar further teaches that the hosts in the network communicates by sending/receiving IP packets, wherein the encapsulation includes plurality of network media types (TCP/IP, ATM, Ethernet).

Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching of Civanlar into teaching of Fechalos to couple to the Internet.

Regarding claims 5, 16, 17, and 19-22, refer to claim 3, wherein the Internet includes a plurality of routers.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SOON-DONG D. HYUN whose telephone number is (571)272-3121. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chi H Pham/
Supervisory Patent Examiner, Art Unit 2616
6/9/08

/Soon D Hyun/
Examiner, Art Unit 2616